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EXAMINER

TRAN, DOUGLAS Q

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 01/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/688,475

Applicant(s)

KEENEY ET AL.

Examiner

Douglas Q. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4579.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For at least claims 1 and 46, “storing the print job at the spooling server” and “receiving a polling request for the print job at the spooling server from a printer polling device” renders the claims indefinite because of the following reasons:

- 1) the print job does not specify its command parameters to instruct the spooling server how only to store the print job;

- 2) the print job does not specify its command parameters to instruct the spooling server how for processing the document or image data included in the print job;

- 3) the print job does not specify its instruction parameters to instruct the spooling server for transmitting the print job to the suitable printer or the user-desired printer in the network based on the user command;

- 4) how the printer polling device knows the print job located at the spooling server in order to request the print job; and

- 5) how the printer-polling device knows that the print job should be retrieved to the printer-polling device without communicating with the user who generates the print job including the print data and print commands.

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6) the print job does not specify the instruction parameters included in the print job to print the print data.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6, 12-34, 39-45, 46-49, 51,57-79, 84-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Savitzky (US Patent No. 6,012,083) and Chan et al. (US Patent No. 6,378,070).

As to claim 1, Savitzky teaches that a method of receiving, storing, and forwarding a print job over a network, comprising:

forwarding the print job (i.e., document) to a spooling server (i.e., agency 32 in fig. 3);
receiving the print job at the spooling server(the proxy agent 36 in the agency 32 receiving the document from the server A, col. 10, lines 26-27);

storing the print job at the spooling server (the document is stored into the queue as a transaction when the document is received, col. 10, lines 40-41).

Receiving a polling request for the print job at the spooling server from a printer polling device (i.e., client A is recipient who sends the document requests, col. 10, lines 33-34); and

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Forwarding the requested print job from the spooling server to the printer-polling device (client A is recipient who sends the document requests and receives the requested document, col. 10, lines 51-52).

However, Savitzky does not teach client A polling request the document, which is previously stored in the server, for printing.

Chan, in the same field of endeavor, teaches the print spooler or print server (130 in fig. 1) stores encrypted document files (col. 3, lines 54-56) and forwards the document to the requested devices (i.e., a printer or a smart card user) for printing (col. 3, line 54 to col. 4, line 17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the server of Savitzky for forwarding the requested document to requested devices as taught by Chan. The suggestion for modifying the system of Savitzky can be reasoned by one of ordinary skill in the art as set forth by Chan because 1) the printing system has more securely by retrieving the document only when been requested; 2) the printing system has more securely by retrieving the document only when user identity is specified.

As to claim 2, Savitzky teaches that the print job is printed at a printer (62 in fig. 5) coupled to the printer polling device (60 in fig. 5) (in this case, the printer agency 60 in fig. 5 is the printer polling device for receiving the print job for printing at a printer 62, col. 12, line 66 to col. 13, line 2).

As to claim 3, Savitzky teaches that the printer is located at a location remote from the spooling server (see fig. 5).

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As to claim 4, Savitzky teaches that the print job is forwarded to the spooling server without a pre-determined print destination (with this condition, the print job is treated as a document with a transferred document format 66 in fig. 5 without a command data for instructing the printing at the suitable printer).

As to claim 6, Savitzky teaches that the network comprises: at least one of LANs, a WAN, a global network, and the Internet (col. 1, lines 12-17).

As to claim 12, Savitzky teaches that the spooling server is capable of storing multiple print jobs in at least one spooling queue (col. 6, line 28).

As to claim 13, Savitzky teaches that providing for encryption of the print job at a print job source; and providing for decryption of the print job at the printer-polling device (col. 14, lines 25-26).

As to claim 14, Savitzky teaches that the print job comprises a document provided by a content provider (col. 10, lines 36-39).

As to claim 15, Savitzky teaches that the content provider is one of a newspaper, a magazine, a periodical, a document provider, a graphic arts provider, a notification service, an Internet content provider, a merchant, a financial institution, a government agency, or a shipping company (66 in fig. 5, col. 49-52).

As to claim 16, Savitzky teaches that a single print job is provided by the content provider for multiple users (12 in fig. 1).

As to claims 17-18, Savitzky teaches that the print job is provided by the content provider on a subscription basis and a fee is charged to access the spooling server (i.e., the transaction, col. 10, lines 39-42).

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As to claim 19, Savitzky teaches that storing each print job at the spooling server according to a personal identification number (PIN) (col. 12, lines 17-19).

As to claim 20, Savitzky teaches that communicating from the spooling server to the printer polling device a list of print jobs associated with the PIN which are stored at the spooling server; and providing for the selection of a print job (col. 12, lines 17-19).

As to claim 21, Savitzky teaches that storing a plurality of print jobs on the spooling server according to the PIN (col. 12, lines 17-19).

As to claim 22, Savitzky teaches that the PIN is provided to the spooling server via one of a user interface associated with the printer polling device, a telephone, a computer, an Internet appliance, a facsimile machine, a scanner, a personal digital assistant device, or a dedicated terminal; The list of available print jobs is displayed on one of a user interface associated with the printer polling device, a telephone, a computer, an Internet appliance, a facsimile, a scanner, a personal digital assistant device, or a dedicated terminal (table 1 in col. 6).

As to claim 23, Savitzky teaches that providing for designation of a desired print location for the print job at a print job source; providing for communication of the desired print location to the spooling server; printing the print job at the desired print location when the printer polling device at the desired print location polls the spooling server and identifies the print job (see fig. 5 and col. 13, lines 1-2).

As to claims 24-26, Savitzky teaches that providing for designation of a substantially specific time for printing a print job; making the print job available for printing from the spooling server only at the designated substantially specific time; providing for a designated lifetime of the print job, wherein the print job will be stored only for the designated lifetime;

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providing for a designated number of printings of the print job, wherein the print job can only be printed the designated number of times (the options which allow the clients control the print job).

As to claim 27, Savitzky teaches that the print job is one of a negotiable instrument, a stamp, a coupon, a certificate, a check, a unit of currency, a token, or a receipt (66 in fig. 5).

As to claim 28, Savitzky teaches that providing for the designation of one or more recipients of the print job, wherein the print job can only be printed by the designated one or more recipients (20 in fig. 1).

As to claim 29-33, Savitzky teaches that the printer polling device communicates printer status to the spooling server; the printer status comprises at least one of a printer ready indication, an online indication, toner level information, paper supply information, or error information; notifying a printer operator when the printer status indicates that the printer requires attention; providing the operator with vendor contact information to facilitate obtaining printer supplies or service; providing for automatic on line ordering of printer supplies as required by printer status (col. 13, lines 25-28).

As to claim 34, Savitzky teaches that the print job comprises at least one of a document, a poster (66 in fig. 5).

As to claim 39, Savitzky teaches that communications with the spooling server are enabled via at least one of a telephone, a personal digital assistant device, a computer, an Internet appliance, a web browser, or a dedicated terminal (18 in fig. 1).

As to claim 40, Savitzky teaches that providing a communication device for providing the status of the print job stored on the spooling server (col. 3, lines 58-64).

As to claim 41, Savitzky teaches that the status of the print job comprises at least one of filename , file size, author, creation date, print job lifetime, image, title, contents, personal id, recipient, job number, or reference number (col. 3, lines 45-52).

As to claim 42, Savitzky teaches that the communication device comprises one of a telephone, a computer, an Internet appliance, a personal digital assistant device, or a dedicated terminal (10 in fig. 1).

As to claim 43, Savitzky teaches that the print job source is one of a computer, a personal digital assistant device, an Internet appliance, a facsimile, a scanner, a telephone, or a dedicated terminal (12 in fig. 1).

As to claim 44, Savitzky teaches that the printer-polling device is capable of polling multiple spooling servers (14 in fig. 1).

As to claim 45, Savitzky teaches that providing for the communication between the spooling server (10 in fig. 1) and other servers (14 in fig. 1); and receiving a print job from at least one of the other servers at the spooling server (col. 5, lines 6-8).

As to claims 46-49, 51,57-79, 84-90, Savitzky teaches the apparatus for performing the method claims 1-4, 6, 12-34, 39-45 as indicated above.

5. Claims 5, 35-38, 50 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Savitzky, Chan , in view of claims 1 and/or 46, and Newton et al. (US Patent No. 6,334,142 B1).

As to claim 5, Savitzky teaches every feature in claim 1 as indicated above.

However, neither Savitzky nor Chan teach the printer polling device periodically polls the spooling server to identify print jobs associated with the printer-polling device.

Newton, in the same field of endeavor, teaches the printer polling device periodically polls the spooling server to identify print jobs associated with the printer polling device (col. 1, lines 48-53).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication system of either Savitzky or Chan for periodically polling the spooling server to identify print jobs associated with the printer polling device as taught by Newton. The suggestion for modifying the communication system of Savitzky or Chan can be reasoned by one of ordinary skill in the art as set forth by Newton because Newton teaches communication devices relates to supplying messages on the purpose of keep tracking documents on the network by transmitting requests automatically at periodic intervals to the server from the first computer for messages from another computer.

As to claims 35-37, Newton teaches that providing an agent program that provides a directory of documents (the messages are stored on the server as files) to the spooling server, the agent program enabling a client device associated with the print job source to poll the spooling server to determine whether the spooling server requires a document from the directory to complete a print job; and uploading the document from the client device to the spooling server. Communicating the directory to the printer polling device; presenting the directory at the printer polling device; providing for selection of a print job from the directory (col. 1, lines 43-53).

As to claim 38, Newton teaches that the client device periodically polls the spooling server (col. 1, lines 48-53).

As to claims 50 and 80-83, combination of Savitzky and Newton teaches the apparatus for performing the method claims 5, 35-38.

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6. Claims 7-11 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Savitzky, Chan, in view of claims 1 and/or 46, and Pearson (US Patent No. 6,023,684).

As to claim 7, Savitzky teaches every feature in claim 1. Furthermore, Savitzky teaches communication between any the computers (nodes) can occur on the Internet so long as both computers are connected somewhere to the Internet which refers to a global internetwork of networks (col. 1, lines 12-17).

However, neither Savitzky nor Chan teach the printer polling device is located within a gateway firewall; and the spooling server is located outside the gateway firewall.

Pearson, in the same field of endeavor, teaches the printer polling device (any of computers in the network) is located within a gateway firewall; and the spooling server is located outside the gateway firewall (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines 32-35).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the communication system of Savitzky or Chan in order to the printer polling device is located within a gateway firewall; and the spooling server is located outside the gateway firewall as taught by Pearson. The suggestion for modifying the system of Savitzky or Chan can be reasoned by one of ordinary skill in the art as set forth by Pearson because Pearson provides a security system in the network in which the documents of the users in the network are filtered by a proxy firewall. The resultant system of Pearson would allow any document of Savitzky or Chan to be maintained on the security system.

As to claim 8, Savitzky teaches that the print job is forwarded to the spooling server as web-style traffic and received at the printer-polling device as web-style traffic (see HTTP channels in fig. 1).

As to claim 9, Newton teaches that the print job is forwarded to the spooling server such that reconfiguration of the gateway firewall is not required (col. 6, lines 10-13).

As to claim 10, Savitzky teaches that a print job source is located at and in communication with a first LAN and forwards the print job to the spooling server; the printer polling device is located at and in communication with a second local area network; and the spooling server is located outside of the first and second LANs (col. 1, lines 12-17).

As to claim 11, Newton teaches that the print job source communicates with the spooling server via a first gateway firewall which controls access to the first LAN; and the printer polling device communicates with the spooling server via a second gateway firewall which controls access to the second LAN (col. 5, line 54 to col. 6, line 1; col. 7, lines 33-39 and col. 10, lines 32-35).

As to claims 52-56, combination of Savitzky and Pearson teaches the apparatus claims for performing the method claims 7-11.

Response to Arguments and Amendment

Applicant's arguments filed 11/18/02 have been fully considered but they are not persuasive.

Applicant argued in pages 5-7 that Applicants submit that in the claimed invention, all print jobs sent to the server are stored. This is commonly the function of a print "spooler" and

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would be understood by one skilled in the art to be the function of a “ spooling server”. There are various ways of implementing storage on a spooler that are known in the art of printing. In reply, the limitation of “the print job”, which is cited in the independent claims 1 and 46, is not for printing but just for storing at the server. The spooling server just receives and stores the print job. the spooling server does not know to do anything with the print job but just for storing; and forwarding the print job to the requested device. In general, the print job is not for printing but just for transferring. the limitation of “print job” in claims 1 and 46 is merely a document or a file that is transferred from an originated device to a server and to the requested device.

Therefore, the claims 1-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because:

- 1) the print job does not specify its command parameters to instruct the spooling server how only to store the print job;

- 2) the print job does not specify its command parameters to instruct the spooling server how for processing the document or image data included in the print job;

- 3) the print job does not specify its instruction parameters to instruct the spooling server for transmitting the print job to the suitable printer or the user-desired printer in the network based on the user command;

- 4) how the printer polling device knows the print job located at the spooling server in order to request the print job; and

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5) how the printer-polling device knows that the print job should be retrieved to the printer-polling device without communicating with the user who generates the print job including the print data and print commands.

6) the print job does not specify the instruction parameters included in the print job to print the print data.

Applicant asserted in page 9 “ the Examiner has acknowledgment that Savitzky does not disclose a method of polling a spooling server to retrieve a print job stored at the spooling server as claimed by Applicants “. In reply, the new cited prior art of Chan would modify to the deficiency of Savitzky for requesting the print job from the server for printing at the requested device such as a printer or smart card user (col. 3, lines 54 to col. 4, lines 17).

Applicant asserted in pages 10 and 11 “ Newton does teach how to use polling to retrieve “ message” such as email, but does not teach to use the polling method in the printing application. Further Newton does not teach that such polling would be applicable in combination with other techniques for the application of networked printing.” In reply, Newton teaches the documents (i.e., a message in email) stored in the server and a client (i.e., the printer polling device) for periodically polls the server to identify print jobs associated with the printer polling device (col. 1, lines 43-55 describes that the messages in email are stored on the server as files and then transmitted to clients operated by intended recipients as files). Therefore, the files requested by a client and can be printed at the client side.

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Applicant asserted in page 12 " In contrast, the present invention is directed at ease of deployment on the local client network behind the proxy/firewall (see "B" in the diagram)). In reply, Pearson teaches the firewall or the security is provided to the client (col. 5, lines 61-65 describes that Client messages which are in the format of a known internet service, such as email, FTP are delivered to a proxy firewall before being delivered to the server which supports the Internet services; and also, col. 10, lines describes that Firewall 54 permits customer service computers 52 which are coupled together through a computer network to utilize Internet services, such as email, WWW, FTP, Telnet, Rlogin and Usenet in a secure manner.). Therefore, the files, which are transferred anywhere in the global internetwork, is secured by Firewall. The communication between devices in the global internetwork is secured by Firewall.).

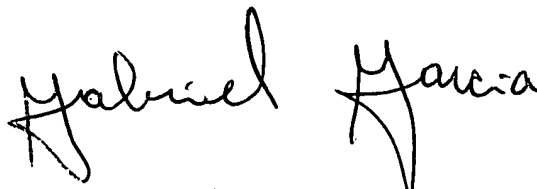
For the above reasons, it is believed that the cited prior art fully discloses the claimed invention and the rejection stand.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas Q. Tran whose telephone number is (703) 305-4857 or E-mail address is Douglas.tran@uspto.gov.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Douglas Q. Tran
Dec. 24, 2002


GABRIEL GARCIA
PRIMARY EXAMINER